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1                   UNITED STATES PATENT AND TRADEMARK OFFICE  
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4                   BEFORE THE BOARD OF PATENT APPEALS  
5                   AND INTERFERENCES  
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8                   *Ex parte* STEPHEN C. WREN  
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11                   Appeal 2008-2765  
12                   Application 08/650,834  
13                   Technology Center 3600  
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16                   Decided: <sup>1</sup>March 31, 2009  
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19                  *Before* MURRIEL E. CRAWFORD, HUBERT C. LORIN and JOSEPH A.  
20                  FISCHETTI, *Administrative Patent Judges*.

21  
22                  CRAWFORD, *Administrative Patent Judge*.  
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25                   DECISION ON APPEAL  
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27                   STATEMENT OF THE CASE  
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<sup>1</sup> The two month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304 (2008), begins to run from the Decided Date shown on this page of the decision. The time period does not run from the Mail Date (paper delivery) or the Notification Date (electronic delivery).

1           Appellant appeals under 35 U.S.C. § 134 (2002) from a final rejection  
2 of claims 30-36, 38-45, 47-54, 57-64, 67-116, and 121-143. We have  
3 jurisdiction under 35 U.S.C. § 6(b) (2002).

4           Appellant invented a system and means for establishing a  
5 communicating link between remote facilities (Specification 1:12-13).

6           Independent claim 30 under appeal read as follows:

7           30. An apparatus to market and/or sell goods  
8 and/or services over an electronic network  
9 comprising:

10           a first computerized central communications  
11 facility adapted to be linked to a computerized  
12 remote facility and to a plurality of other  
13 computerized central communications facilities,  
14 each of said first or other computerized central  
15 communications facilities having information  
16 relating to goods or services stored in a database,  
17 and each of said first or other computerized central  
18 communications facilities having a processor  
19 programmed to:

20           receive from a customer located at said  
21 computerized remote facility a request to at least  
22 one of search, browse and access in said database  
23 at said first or other computerized central  
24 communications facility for information of  
25 interest;

26           enable said customer to at least one of  
27 search, browse and access said database for  
28 information of interest; and

29           transmit said information of interest from  
30 the database at said computerized central  
31 communications facility to said computerized  
32 remote communications facility;

1                   wherein at least one of said computerized  
2                   central communications facilities is adapted to  
3                   provide to said customer at said computerized  
4                   remote facility a list of computerized central  
5                   communications facilities permitting said customer  
6                   to select and contact at least one other  
7                   computerized central communications facility to  
8                   request additional information relating to said  
9                   goods or services.

10                  The prior art relied upon by the Examiner in rejecting the claims on  
11                  appeal is:

Dworkin	US 4,992,940	February 12, 1991
McCalley et al.	US 5,191,410	March 2, 1993
Filepp	US 5,347,632	September 13, 1994
Lockwood	US 5,576,951	November 19, 1996
Gifford	US 5,724,424	March 3, 1998
Saigh et al.	US 5,734,823	March 31, 1998
Ferguson et al.	US 5,819,092	October 6, 1998
Wren	US 6,055,514	April 25, 2000

22                  *ATT Services: AT&T provides compass, Communications*

23                  International, London, July 1993, Vol. 20, Iss. 7, p. 6, 2 pages (hereinafter  
24                  “AT&T”).

25                  *InTouch Internet Shopping Network (ISN) launches Interactive Home*

26                  *Music Shopping Service with intouch group, inc. for Internet Users*

27                  *Worldwide; online service features more than 40,000 music titles in 21*  
28                  *genres.* Business Wire, 11 April 1995 (hereinafter “InTouch”).

29                  The Examiner rejected claims 115, 116, 121, 122 and 140-143 under

30                  35 U.S.C. § 102(e) as being anticipated by Saigh; claim 123 under 35 U.S.C.  
31                  § 102(e) as being anticipated by Gifford; claims 30-33, 36, 39-45, 47, 49, 51,  
32                  54, 57-64, 67, 79-85, 87-90, 92 and 100 under 35 U.S.C. § 103(a) as being

1 unpatentable over AT&T in view of Dworkin; claims 50, 72, 77, 78 and 86  
2 under 35 U.S.C. § 103(a) as being unpatentable over AT&T in view of  
3 Dworkin and McCalley; claims 34, 35, 38, 48, 52, 53, 68, 69, 94, 95, 103  
4 and 107 under 35 U.S.C. § 103(a) as being unpatentable over AT&T in view  
5 of Dworkin and Filepp; claims 70-76 under 35 U.S.C. § 103(a) as being  
6 unpatentable over AT&T in view of Dworkin and McCalley; claims 93, 96-  
7 98, 101 and 104-106 under 35 U.S.C. § 103(a) as being unpatentable over  
8 AT&T in view of Dworkin and Examiner's Official Notice; claims 108,  
9 110-114 and 139 under 35 U.S.C. § 103(a) as being unpatentable over  
10 Saigh in view of Lockwood; claim 109 under 35 U.S.C. § 103(a) as being  
11 unpatentable over Saigh in view of Lockwood and Ferguson; claim 139  
12 under 35 U.S.C. § 103(a) as being unpatentable over Saigh in view of  
13 Lockwood; claim 124 under 35 U.S.C. § 103(a) as being unpatentable over  
14 Saigh; claim 125 under 35 U.S.C. § 103(a) as being unpatentable over  
15 Gifford in view of Ferguson; claims 126 under 35 U.S.C. § 103(a) as being  
16 unpatentable over Gifford in view of Lockwood; claims 127-129 under  
17 35 U.S.C. § 103(a) as being unpatentable over Gifford in view of Saigh;  
18 claims 130-132 and 135-137 under 35 U.S.C. § 103(a) as being unpatentable  
19 over Saigh in view of Kaplan/InTouch; claim 133 under 35 U.S.C. § 103(a)  
20 as being unpatentable over Saigh in view of InTouch and Ferguson; claim  
21 134 under 35 U.S.C. § 103(a) as being unpatentable over Saigh in view of  
22 Lockwood; claim 138 under 35 U.S.C. § 103(a) as being unpatentable over  
23 Saigh in view of Ferguson; claim 30 under the judicially created doctrine of  
24 obviousness-type double patenting as being unpatentable over Wren in  
25 view of AT&T and Dworkin; and claims 108-114 and 130-143 under the

1 judicially created doctrine of obviousness-type double patenting as being  
2 unpatentable over Wren in view of Saigh, Ferguson, InTouch, and  
3 Lockwood.

4

5 SUMMARY OF THE DECISION

6 We affirm the rejections of claims 30, 31, 33-36, 38, 40, 42-45, 47-52,  
7 57, 59-68, 70-94, 96-102, 104-107, 123 and 126.

8 We reverse the rejections of claims 32, 39, 41, 53, 54, 58, 69, 95, 103,  
9 108-116, 121, 122, 124, 125, and 127-143.

10 We also use our authority under 37 C.F.R. § 41.50(b) to enter two  
11 new grounds of rejection: (1) claims 53, 95 and 103 are rejected under  
12 35 U.S.C. § 103(a) as being unpatentable over AT&T, Dworkin and Filepp;  
13 and (2) claims 93 and 101 are rejected under 35 U.S.C. § 103(a) as being  
14 unpatentable over AT&T and Dworkin.

15

16 PRINCIPLES OF LAW

17 *Filing Date*

18 The applicant for a United States patent bears the burden of  
19 establishing its entitlement to the filing date of a previously filed application.  
20 *Wagoner v. Barger*, 463 F.2d 1377, 1380 (CCPA 1972).

21 In order for a reference to claim an effective filing date of an  
22 application to which it claims priority under 35 U.S.C. § 102(e), the  
23 application must disclose, pursuant to §§120/112, the invention claimed in  
24 the reference. *In re Wertheim and Mishkin*, 209 USPQ 554, 565-566  
25 (C.C.P.A. 1981).

1            *Written Description*

2            The written description requirement of 35 U.S.C. § 112, ¶ 1, is  
3 straightforward: The specification shall contain a written description of the  
4 invention .... To satisfy this requirement, the specification must describe  
5 the invention in sufficient detail so that one skilled in the art can clearly  
6 conclude that the inventor invented the claimed invention as of the filing  
7 date sought. *In re Alonso*, 545 F.3d 1015, 1019 (Fed. Cir. 2008).

8

9            *Claim Construction*

10          During examination of a patent application, a pending claim is given  
11 the broadest reasonable construction consistent with the specification and  
12 should be read in light of the specification as it would be interpreted by one  
13 of ordinary skill in the art. *In re Am. Acad. Of Sci. Tech Ctr.*, 367 F.3d 1359,  
14 1364 (Fed. Cir. 2004).

15          While the specification can be examined for proper context of a claim  
16 term, limitations from the specification will not be imported into the claims.  
17 *CollegeNet, Inc. v. ApplyYourself, Inc.*, 418 F.3d 1225, 1231 (Fed. Cir.  
18 2005).

19          A preamble is not limiting where a patentee defines a structurally  
20 complete invention in the claim body and uses the preamble only to state a  
21 purpose or intended use for the invention. *Catalina Mktg. Int'l, Inc. v.*  
22 *Coolsavings.com, Inc.*, 289 F.3d 801, 808 (Fed. Cir. 2002) (quoting *Rowe v.*  
23 *Dror*, 112 F.3d 473, 478 (Fed. Cir. 1997)).

24

25

1            *Obviousness*

2            The test for obviousness is not whether the features of a secondary  
3 reference may be bodily incorporated into the structure of the primary  
4 reference; nor is it that the claimed invention must be expressly suggested in  
5 any one or all of the references. Rather, the test is what the combined  
6 teachings of the references would have suggested to those of ordinary skill  
7 in the art. *In re Keller*, 642 F.2d 413, 425 (CCPA 1981).

8            Once a prima facie case of obviousness is established, the burden  
9 shifts to Appellant to rebut it. *Id.*

10          One cannot show non-obviousness by attacking references  
11 individually where the rejections are based on combinations of references.

12          *Id.*

13

14          *Analogous Art*

15          A reference is analogous art if it is either in the field of the applicant's  
16 endeavor or reasonably pertinent to the particular problem with which the  
17 inventor was concerned. *In re Oetiker*, 977 F.2d 1443, 1447 (Fed. Cir.  
18 1992). In addition, when a work is available in one field of endeavor, design  
19 incentives and other market forces can prompt variations of it, either in the  
20 same field or a different one. For the same reason, if a technique has been  
21 used to improve one device, and a person of ordinary skill in the art would  
22 recognize that it would improve similar devices in the same way, using the  
23 technique is obvious unless its actual application is beyond his or her skill.  
24 *KSR Int'l Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1740 (2007).

25

1           *Related Applications*

2           Examiners are not bound to follow other examiners' interpretations.

3   *Dayco Products Inc. v. Total Containment Inc.*, 329 F.3d 1358, 1368 (Fed.

4 Cir. 2003).

5

6           *Official Notice*

7           To adequately traverse a finding of Official Notice, the Appellant

8 must specifically point out the supposed errors in the Examiner's action,

9 which would include stating why the noticed fact is not considered to be

10 common knowledge or well-known in the art. A general allegation that the

11 claims define a patentable invention without any reference to the Examiner's

12 assertion of Official Notice is inadequate. In the absence of any demand

13 by Appellant for the Examiner to produce authority for his statement, the

14 traversal shall not be considered. *In re Chevenard*, 139 F.2d 711, 713

15 (CCPA 1943).

16

17           *Printed Matter*

18           Where the printed matter is not functionally related to the substrate,

19 the printed matter will not distinguish the invention from the prior art in

20 terms of patentability. *In re Gulack*, 703 F.2d 1381, 1386-86 (Fed Cir.

21 1983).

22

23           *Citing References*

24           Where a reference is relied on to support a rejection, whether or not in

25 a "minor capacity," there would appear to be no excuse for not positively

<sup>1</sup> including the reference in the statement of rejection. *In re Hoch*, 428 F.2d 1341, 1342 n. 3 (CCPA 1970).

3

OPINION

5        Rejection of claims 115, 116, 121, 122, and 140-143 under  
6        35 U.S.C. § 102(e) as being anticipated by Saigh.

The sole issue in regard to this rejection is whether the Appellant has shown that the Examiner erred in asserting that Saigh is prior art to the subject matter of claims 115, 116, 121, 122, and 140-143 because parent Application No. 08/268,309 filed June 29, 1994 (hereinafter the “309 application”) does not provide written description support for multiple central communications facilities.

13 *Findings of Fact*

14 The '309 application discloses an array of central facilities that  
15 communicate with each other and a remote facility. A user accesses the  
16 central facility via the remote facility (p. 5, ll. 8-10; p. 6, l. 31 through p. 7, l.  
17 3; p. 7, ll. 30-35; p. 9, l. 33 through p. 10, l. 7).

18 Saigh has a filing date of July 25, 1996 and is a continuation-in-part of  
19 U.S. Patent Application No. 07/787,536 filed November 4, 1991 (hereinafter  
20 “‘536 application”).

21 The ‘536 application does not disclose information regarding rentals.

22 Analysis

23 Claims 115, 116, 121, 122, and 140-143 have been rejected under  
24 35 U.S.C. § 102(e) as being anticipated by Saigh. This application was filed  
25 on March 29, 1996, and is a continuation-in-part application of the '309

1 application which was filed on June 29, 1994. As an initial matter, we must  
2 determine whether the Appellant has shown that the '309 application  
3 adequately supports the subject matter of the aforementioned claims. *See*  
4 *Wagoner*, 463 F.2d at 1380.

5 The Appellant asserts that the '309 application, to which this  
6 application claim priority, does provide support for multiple central  
7 communications facilities (Appeal Brief 33-34; Reply Brief 1-2). We agree  
8 with the Appellant.

9 The '309 application does provide written description support for  
10 multiple central communications facilities, for example, at p. 5, ll. 8-10; p. 6,  
11 l. 31 through p. 7, l. 3; p. 7, ll. 30-35; p. 9, l. 33 through p. 10, l. 7 of the  
12 '309 application. While the Examiner is correct that Fig. 1 filed with the  
13 '309 application does not show multiple central communications facilities,  
14 all 35 U.S.C. § 112, ¶ 1, requires is that the specification describe the  
15 invention in sufficient detail so that one skilled in the art can clearly  
16 conclude that the inventor invented the claimed invention as of the filing  
17 date sought. *In re Alonso*, 545 F.3d at 1019. *See also, Pandrol USA LP v.*  
18 *Airboss Railway Products Inc.*, 424 F.3d 1161, 1165-1166 (Fed Cir. 2005)  
19 (specification supported modification of drawing to include adhesive layer  
20 12 between plate 10 and tie 1 to comply with 37 C.F.R. § 1.83(a)). The '309  
21 application, even without the drawing, provides adequate written description  
22 support for multiple central communications facilities.

23 Moreover, pages 9-30 of the Appeal Brief identifies extensive support  
24 in the '309 application for the subject matter of the aforementioned claims.  
25 Accordingly, absent an indication by the Examiner that the '309 application

1 does not provide specific support for any particular aspect of the  
2 aforementioned claims, the effective filing date for the aforementioned  
3 claims is the June 29, 1994 filing date of the ‘309 application.

4 Saigh has a filing date of July 25, 1996 and is a continuation of an  
5 application filed December 30, 1994. Saigh is a continuation-in-part of the  
6 ‘536 application, filed November 4, 1991. The ‘536 application does not  
7 disclose information regarding rentals as recited in the aforementioned  
8 claims, and as such is not relevant to the effective filing date of Saigh as it  
9 relates to the subject application. *See In re Wertheim and Mishkin*, 209  
10 USPQ at 565-566. However, the June 29, 1994 effective filing date of the  
11 aforementioned claims antedates the December 30, 1994 effective date of  
12 Saigh.

13 Accordingly, we will not sustain this rejection of claims 115, 116,  
14 121, 122, and 140-143.

15

16 Rejection of claim 123 under 35 U.S.C. § 102(e) as being  
17 anticipated by Gifford

18 The sole issue in regard to this rejection is whether the Appellant has  
19 shown that the Examiner erred in asserting that Gifford discloses using  
20 downloaded software to display or reproduce “information contained in a  
21 transmitted hypermedia document” as recited in claim 123.

22 Findings of fact

23 Gifford discloses that the software architecture underlying the  
24 particular preferred embodiment is based upon the conventions of the World  
25 Wide Web including HTML, and that there are many techniques for

1 representing programs as data for purchase request 24 and purchase message  
2 25 (col. 5, l. 63 through col. 6, l. 2; col. 4, l. 61 through col. 5, l. 6).

3        *Analysis*

4            The Appellant asserts that Gifford only discloses that the downloaded  
5 program is only used to generate a “user purchase request and message,” and  
6 not to “translate information contained in a transmitted hypermedia  
7 document” as recited in claim 123 (Appeal Brief 35; Reply Brief 2). We  
8 disagree with the Appellant.

9            Gifford discloses that “there are many techniques for representing  
10 programs as data” for purchase request 24 and purchase message 25 at col.  
11 5, l. 63 through col. 6, l. 2, and that “[t]he software architecture underlying  
12 the particular preferred embodiment is based upon the conventions of the  
13 World Wide Web” including HTML (col. 4, l. 61 through col. 5, l. 6).  
14 Accordingly, Gifford discloses that the user purchase request 24 and user  
15 purchase message 25 could be in HTML.

16            We will sustain this rejection of claim 123.

17  
18        Rejection of claims 30-33, 36, 39-45, 47, 49, 51, 54, 57-64, 67, 79-  
19        85, 87-90, 92, and 100 under 35 U.S.C. § 103(a) as being unpatentable  
20        over AT&T in view of Dworkin

21        *Findings of Fact*

22            AT&T’s online service is a directory of directories (p. 1, Abstract).  
23            AT&T discloses that before the introduction of CIX, 99% of CerfNet users  
24 were researchers and academics, however, now 90% of users are  
25 commercial. Users of the AT&T directory want know how to contact

1 businesses and how to sell and use services that are available on it (p. 2, ¶  
2 12-14).

3 A user of AT&T's word search may perform a word search on AT&T  
4 to find out where information is located (p. 2, ¶ 1-5).

5 Dworkin discloses an automated system for locating and purchasing  
6 goods or services sold by a plurality of vendors (Abstract).

7 Managers or suppliers may use a virtual bulletin board contained on  
8 the system disclosed in Dworkin to inform users of new products and special  
9 promotions (col. 9, ll. 36-46).

10 A user navigates the database 3 of Dworkin via multiple screen menus  
11 (Figs. 3-4).

12 The specification discloses that a shopper may establish contact with  
13 the central facility's equipment by helping themselves through a self-service  
14 mode of a database which they can browse through for the goods and  
15 services which interest them (p. 20, ll. 20-23).

16

17 **Analysis**

18 ***Market and/or Sell Goods and/or Services***

19 The first issue in regard to this rejection is whether the Appellant  
20 has shown that the Examiner erred in asserting that AT&T discloses an  
21 apparatus to market and/or sell goods and/or services as recited in claims 30  
22 and 44. We sustain the rejection of claim 30 and 44 for the reasons below.

23 The Appellant asserts that AT&T does not disclose a system used to  
24 market and/or sell goods and/or services as recited in claims 30 and 44  
25 because (1) the AT&T directory is a part of InterNIC which is about

1 scientific research and not commerce and (2) the directory itself is not used  
2 to market and/or sells goods and/or services (Appeal Brief 36, 39; Reply  
3 Brief 3, 5, 7). We disagree with the Appellant on this issue. Regardless of  
4 whether AT&T is part of InterNIC, AT&T discloses that users of the AT&T  
5 directory want to know how to contact businesses and how to sell and use  
6 services that are available on it. Under a broadest reasonable interpretation,  
7 using the AT&T directory to sell services meets the recitation of “market  
8 and/or sell goods and/or services.” *See In re Am. Acad. Of Sci. Tech Ctr.*,  
9 367 F.3d at 1364.

10 The Appellant also asserts that AT&T has users while the present  
11 invention has customers (Appeal Brief 36). We once more disagree with  
12 the Appellant on this issue. Under a broadest reasonable interpretation,  
13 “users” can correspond to “customers” absent a specific definition of  
14 customers set forth in the claim. *See Id.; CollegeNet, Inc.*, 418 F.3d at 1231.

15 The Appellant further asserts that the Examiner erred because some of  
16 CerfNet users were researchers and academics (Reply Brief 3, 5, 7). We  
17 disagree with the Appellant. The fact that some of CerfNet users were  
18 researchers or academics is irrelevant. Claims 30 and 44 do not disclose that  
19 the system must be used exclusively to market and/or sell goods and/or  
20 services. *See Id.* As long as some of CerfNet’s users were commercial  
21 users, the recitation of “market and/or sell goods and/or services” is met.

22 Moreover, we note that a preamble, such as the ones set forth in  
23 claims 30 and 44 reciting apparatuses to market and/or sell goods and/or  
24 services, is not limiting where a patentee defines a structurally complete

1 invention in the claim body and uses the preamble only to state a purpose or  
2 intended use for the invention. *Catalina Mktg. Int'l, Inc.*, 289 F.3d at 808.

3

4       *Select and Contact*

5           The second issue in regard to this rejection is whether the Appellant  
6 has shown that the Examiner erred in asserting that AT&T discloses at least  
7 one of said computerized central communications facilities is adapted to  
8 provide to said customer at said computerized remote facility a list of  
9 computerized central communications facilities permitting said customer to  
10 select and contact at least one other computerized central communications  
11 facility as recited in claims 30 and 44.

12          The Appellant asserts that AT&T does not disclose permitting a  
13 customer to select and contact at least one other computerized central  
14 communications facility as recited in claims 30 and 44 (Appeal Brief 37, 39;  
15 Reply Brief 3). We disagree with the Appellant.

16          The claim only recites *permitting* a customer to select and contact at  
17 least one other computerized central communications facility. The claim  
18 does not *require* the customer to select and contact at least one other  
19 computerized central communications facility, through AT&T's software  
20 architecture or otherwise, in order to meet the claim recitation. *See*  
21 *CollegeNet, Inc. v. ApplyYourself, Inc.*, 418 F.3d at 1231.

22          AT&T discloses a directory of directories, and a user performs a  
23 word search on AT&T to find out where information is located, for example,  
24 which directory. Once these results are returned, the user *may* use the  
25 information to contact that directory so as to contact businesses listed in that

1 directory. Accordingly, once the word search results are returned, the user is  
2 *permitted* to select and contact this directory using any suitable means, and  
3 the claim recitation is satisfied under a broadest reasonable interpretation.  
4 *See In re Am. Acad. Of Sci. Tech Ctr.*, 367 F.3d at 1364. The fact that  
5 AT&T may or may not *actually* disclose the user selecting and contacting  
6 the directory, whether through the software architecture of AT&T or other  
7 means, is irrelevant, as those recitations are not set forth in the claims.  
8 *CollegeNet, Inc.*, 418 F.3d at 1231,

9

10       *Motivation*

11       The third issue in regard to this rejection is whether the Appellant has  
12 shown that the Examiner erred in combining the single central facility of  
13 Dworkin with the multiple central facilities of AT&T because there is no  
14 motivation to combine the references.

15       The Appellant asserts that there is no motivation to combine the single  
16 central facility of Dworkin with the multiple central facilities of AT&T  
17 because the systems are fundamentally different (Appeal Brief 37, 39). We  
18 disagree with the Appellant.

19       The test is not whether Dworkin and AT&T can or cannot be merged  
20 wholesale, but whether one or ordinary skill in the art could combine certain  
21 features from each reference with a proper motivation. *In re Keller*, 642  
22 F.2d at 425. Both Dworkin and AT&T disclose buying and selling goods  
23 and services over networks. Accordingly, Dworkin and AT&T appear to be  
24 directed to the same technology that is amenable to substituting features  
25 across references. Absent a showing by Appellant as to what *specific*

1    *technical aspects* of the single central facility of Dworkin and the multiple  
2    central facilities of AT&T prevents the teachings of the references from  
3    being combined in the manner suggested by the Examiner, this line or  
4    reasoning is unconvincing.

5           Moreover, the Examiner has set forth a motivation on pages 9-10 of  
6    the Office Action that “[i]t would have been obvious... to include the [the  
7    information of interest stored in a database of Dworkin] within [the system  
8    of AT&T] for the motivation of providing a system for locating and  
9    purchasing products of interest to a customer (col. 1, lines 8-12 and lines 63-  
10   65).” Absent any specific technical arguments as to why one or ordinary  
11   skill in the art could not place the information of interest of Dworkin within  
12   the system of AT&T, the motivation set forth by the Examiner is proper. *Id.*

13

14         *Non-Analogous Art*

15           The fourth issue in regard to this rejection is whether the Appellant  
16   has shown that the Examiner erred in combining the single central facility of  
17   Dworkin with the multiple central facilities of AT&T because Dworkin and  
18   AT&T are non-analogous art.

19           The Appellant asserts that Dworkin and AT&T are non-analogous  
20   art (Appeal Brief 37, 39). We disagree with the Appellant on this issue. A  
21   reference is analogous art if it is either in the field of the applicant's  
22   endeavor or reasonably pertinent to the particular problem with which the  
23   inventor was concerned. *In re Oetiker*, 977 F.2d at 1447. AT&T, Dworkin  
24   and the present invention are all directed to buying and selling goods over

1 networks. Accordingly, because they are all in the same field of endeavor,  
2 they are all analogous art.

3

4       *Contact the Customer*

5           The fifth issue, however, in regard to this rejection is whether the  
6 Appellant has shown that the Examiner erred in asserting that Dworkin  
7 discloses “wherein at least one of said computerized central communications  
8 facilities is further programmed to contact the customer and apprise said  
9 customer of goods or services offered or any special offerings” as recited in  
10 claim 32.

11          The Examiner asserts that Dworkin discloses a central facility  
12 contacting a customer to apprise them of goods or services offered or special  
13 offerings, as recited in claim 32, because Dworkin discloses a virtual bulletin  
14 board on a computerized system where managers and suppliers can inform  
15 users of new products and special promotions (Examiner’s Answer 5-6).  
16 We disagree with the Examiner and agree with the Appellant’s arguments on  
17 page 37 of the Appeal Brief and page 4 of the Reply Brief.

18          The virtual bulletin board in Dworkin can only provide information to  
19 the customer if the customer accesses the virtual bulletin board, i.e., the  
20 customer contacts the central facility. Even then, the customer is obtaining  
21 the information from the virtual bulletin board, as no further action,  
22 contacting or otherwise, is undertaken by any of the virtual bulletin board,  
23 the managers or the suppliers.

24          For this reason, we will not sustain this rejection of claim 32.

25

1           *Competing Providers*

2           The sixth issue in regard to this rejection is whether the Appellant has  
3           shown that the Examiner erred in asserting that AT&T discloses “wherein  
4           said computerized central communications facility and each of said other  
5           computerized central communications facilities are associated with  
6           competing providers of goods and services” as recited in claim 33.

7           The Appellant asserts that the Examiner has failed to cite a specific  
8           passage of AT&T which discloses that the computerized central  
9           communications facilities are associated with competing providers as recited  
10          in claim 33 (Appeal Brief 38; Reply Brief 4). We disagree with the  
11          Appellant. AT&T discloses that it is a directory of directories. Each  
12          directory is associated with a competing provider under a broadest  
13          reasonable interpretation. *In re Am. Acad. Of Sci. Tech Ctr.*, 367 F.3d at  
14          1364.

15          We will sustain this rejection of claim 33.

16

17           *Stopping Point in User Presentation*

18          The seventh issue in regard to this rejection is whether the Appellant  
19          has shown that the Examiner erred in taking Official Notice of providing a  
20          stopping point in a user presentation as recited in claims 36 and 51.

21          The Appellant asserts that the Official Notice of the “presentation  
22          stopping point” recited in claims 36 and 51 was improper because this  
23          limitation was found to be novel and an inventive step in another related  
24          application (Appeal Brief 38, 40; Reply Brief 4, 6). We disagree with the  
25          Appellant.

1           As an initial matter, Examiners are not bound to follow other  
2 examiners' interpretations. *Dayco Products Inc. v. Total Containment Inc.*,  
3 329 F.3d at 1368. Accordingly, the finding in the related application is  
4 given no weight.

5           Moreover, Appellant has not provided any factual or technical  
6 arguments as to why the Official Notice is improper, i.e., why a  
7 "presentation stopping point" is not capable of instant and unquestionable  
8 demonstration as being well-known. Absent such arguments, Appellant  
9 cannot prevail. *In re Chevenard*, 139 F.2d 711, 713.

10          We will sustain this rejection of claims 36 and 51.

11

12          *Downloading Software*

13          The eighth issue in regard to this rejection is whether the Appellant  
14 has shown that the Examiner erred in asserting that AT&T discloses a  
15 processor programmed to download software from a computerized central  
16 communications facility to a remote communications facility as recited in  
17 claims 39, 41 and 58.

18          The Examiner asserts that AT&T's disclosure of downloading  
19 information concerning the directory of directories to the user's computer  
20 corresponds to downloading software from the computerized central  
21 communications facilities as recited in claims 39, 41 and 58 (Examiner's  
22 Answer 7, 9). We disagree with the Examiner and agree with the  
23 Appellant's arguments on pages 38-40 of the Appeal Brief and page 4 of the  
24 Reply Brief. Downloading *information or data*, as set forth in AT&T, does  
25 not correspond to downloading *software*.

1           Accordingly, we will not sustain this rejection of claims 39, 41 and 58  
2 under the Examiner's current rationale.

3

4           *Second Central Communications Facility*

5           The ninth issue in regard to this rejection is whether the Appellant has  
6 shown that the Examiner erred in asserting that Dworkin discloses "a second  
7 central communications facility having a database of information relating to  
8 a second set of information relating to goods or services to provide upon  
9 request" as recited in claim 44.

10          The Appellant asserts that Dworkin only discloses one database which  
11 cannot correspond to a second central communications facility having a  
12 database as recited in claim 44 (Appeal Brief 39). However, AT&T  
13 discloses a directory of directories, each of which is a central  
14 communications facility having a database. One cannot show non-  
15 obviousness by attacking references individually where the rejections are  
16 based on combinations of references. *In re Keller*, 642 F.2d at 425.

17          We will sustain this rejection of claim 44.

18

19           *Downloading Contract*

20          The tenth issue in regard to this rejection is whether the Appellant  
21 has shown that the Examiner erred in asserting that Dworkin discloses "a  
22 software application for assisting the central communications facility to  
23 download a contract to the computerized remote location" as recited in claim  
24 54.

1       The Examiner asserts that the sending of the transaction number of  
2   an order to a user in Dworkin corresponds to a software application for  
3   assisting the central communications facility to download a contract to a  
4   computerized remote location as recited in claim 54 (Examiner's Answer 9).  
5   We disagree with the Examiner and agree with the Appellant's arguments  
6   on page 40 of the Appeal Brief and page 6 of the Reply Brief. A mere  
7   transaction number, while an indication of the existence of a contract, is not  
8   a contract in and of itself.

9           We will not sustain this rejection of claim 54.  
10

11           *Browsing*

12       The eleventh issue in regard to this rejection is whether the Appellant  
13   has shown that the Examiner erred in asserting that Dworkin discloses  
14   “wherein said first central communications facility further enables said  
15   customer to browse said first set of information relating to goods and  
16   services” as recited in claim 79.

17       The Appellant asserts that navigating the screen menus of Dworkin  
18   does not correspond to browsing as recited in claim 79 because the browsing  
19   is not done over the Internet (Appeal Brief 41; Reply Brief 6-7). We  
20   disagree with the Appellant. The definitions of browsing set forth by  
21   Appellant on page 23, lines 20-23 of the Specification and page 41 of the  
22   Appeal Brief both include scanning and viewing files in a computer  
23   database. Dworkin discloses such “scanning and viewing” of files in  
24   database 3 via view screen menus.

25           We will sustain this rejection of claim 79.

1

2        *Search First and Second Database*

3        The twelfth issue in regard to this rejection is whether the Appellant  
4 has shown that the Examiner erred in asserting that Dworkin discloses  
5 “enabling the remote facility to search said first database or said second  
6 database” as recited in claim 81.

7        The Appellant asserts that Dworkin does not disclose “enabling the  
8 remote facility to search said first database or said second database” as  
9 recited in claim 81 because Dworkin only discloses one database (Appeal  
10 Brief 41; Reply Brief 7). Claim 81 recites “enabling the remote facility to  
11 search said first database *or* said second database” (emphasis added). As  
12 long as the remote facility can search *at least one* of the first database and  
13 the second database, such as database 3 in Dworkin, the claim recitation is  
14 met. Moreover, AT&T discloses a directory of directories with multiple  
15 databases.

16        We will sustain this rejection of claim 81.

17

18        *Other Claims*

19        The thirteenth issue in regard to this rejection is whether the Appellant  
20 has shown that the Examiner erred in rejecting claims 31, 40, 42, 43, 45, 47,  
21 49, 51, 57-64, 67, 80, 82-85, 87-90, 92 and 100.

22        In addition to a lack of motivation for combining AT&T and  
23 Dworkin, which has been addressed above, the Appellant asserts that claims  
24 31, 40, 42, 43, 45, 47, 49, 51, 57, 59-64, 67, 80, 82-85, 87-90, 92 and 100  
25 are also allowable because they either (1) depend from an allowable claim,

1 or (2) are substantially similar to an allowable claim (Appeal Brief 39-42;  
2 Reply Brief 5). We disagree with the Appellant. The rejection of the claims  
3 from which these claims either depend or are substantially similar to has  
4 been sustained. Accordingly, the rejection of these claims is also sustained.  
5

6       Rejection of claims 50, 72, 77, 78, and 86 under 35 U.S.C. § 103(a)  
7 as being unpatentable over AT&T in view of Dworkin and McCalley

8       The sole issue in regard to this rejection is whether the Appellant has  
9 shown that the Examiner erred in rejecting claims 50, 72, 77, 78 and 86.

10       The Appellant asserts that claims 50, 72, 77, 78 and 86 are allowable  
11 because they either (1) depend from an allowable claim, or (2) are  
12 substantially similar to an allowable claim (Appeal Brief 42). We disagree  
13 with the Appellant. The rejection of the claims from which these claims  
14 either depend or are substantially similar to has been sustained.

15       Accordingly, the rejection of these claims is also sustained.

16  
17       Rejection of claims 34, 35, 38, 48, 52, 53, 68, 69, 94, 95, 103, and  
18 107 under 35 U.S.C. § 103(a) as being unpatentable over AT&T in view  
19 of Dworkin and Filepp

20       *Findings of Fact*  
21       Filepp discloses an interactive computer system network that enables  
22 a user to display desired information, such as news, financial, and cultural  
23 information, and perform desired transactional services, such as banking  
24 and shopping, through any of a plurality of types of personal computers  
25 (Abstract).

1       The applications on the interactive computer system network of  
2 Filepp include text/graphic sessions, presentation data, videotext, sounds,  
3 graphics data, pictorial codes and presentation media (col. 2, ll. 23-38; col.  
4 18, ll. 40-55; col. 59, ll. 53-62; col. 65, ll. 50-64; col. 83, ll. 3-11; col. 90, l.  
5 60 through col. 91, l. 13).

6

7       Analysis

8       *Motivation*

9       The first issue in regard to this rejection is whether the Appellant has  
10 shown that the Examiner erred in combining the single central facility of  
11 Filepp with the multiple central facilities of AT&T because there is no  
12 motivation to combine the references.

13       The Appellant asserts that there is no motivation to combine the  
14 single central facility of Filepp with the multiple central facilities of AT&T  
15 because the systems are fundamentally different (Appeal Brief 42-44; Reply  
16 Brief 8-9). We disagree with the Appellant.

17       The test is not whether Filepp and AT&T can or cannot be merged  
18 wholesale, but whether one of ordinary skill in the art could combine certain  
19 features from each reference with a proper motivation. *In re Keller*, 642  
20 F.2d at 425. Both Filepp and AT&T disclose buying and selling goods and  
21 services over networks. Accordingly, Filepp and AT&T appear to be  
22 directed to the same technology that is amenable to substituting features  
23 across references. Absent a showing by Appellant as to what *specific*  
24 *technical aspects* of the single central facility of Filepp and the multiple  
25 central facilities of AT&T prevents the references from being combined

1 in the manner suggested by the Examiner, this line or reasoning is  
2 unconvincing.

3 Moreover, the Examiner has set forth a motivation on pages 19-20 of  
4 the Office Action that “[i]t would have been obvious... to include [in at least  
5 one computerized central communications facility] an audio communication  
6 device for communication with said computerized remote communications  
7 facility as disclosed by Filepp within AT&T and Dworkin for the motivation  
8 of providing large numbers of users to applications containing interactive  
9 text/audio/graphics (col. 2, lines 22-27).” Absent any specific technical  
10 arguments as to why one or ordinary skill could not place the interactive  
11 text/audio/graphics of Filepp within the systems of AT&T and Dworkin, the  
12 motivation set forth by the Examiner is proper. *Id.*

13

14 *Non-Analogous Art*

15 The second issue in regard to this rejection is whether the Appellant  
16 has shown that the Examiner erred in combining the single central facility  
17 of Dworkin with the multiple central facilities of AT&T because Filepp and  
18 AT&T are non-analogous art.

19 The Appellant asserts that Filepp and AT&T are non-analogous art  
20 (Appeal Brief 42-44; Reply Brief 8-9). We disagree with the Appellant. A  
21 reference is analogous art if it is either in the field of the applicant's  
22 endeavor or reasonably pertinent to the particular problem with which the  
23 inventor was concerned. *In re Oetiker*, 977 F.2d at 1447. AT&T, Filepp  
24 and the present invention are all directed to buying and selling goods over

1 networks. Accordingly, because they are all in the same field of endeavor,  
2 they are all analogous art.

3

4 *Audio or Video Presentations*

5 The third issue in regard to this rejection is whether the Appellant  
6 has shown that the Examiner erred in asserting that Filepp discloses  
7 computerized communications facilities adapted to provide information  
8 relating to goods and services in the form of an audio or video presentation  
9 as recited in claims 35, 48 and 68.

10 The Appellant asserts that Filepp's disclosure of audio signals and  
11 videotext cannot correspond to audio or video presentations as recited in  
12 claims 35, 48 and 68 (Appeal Brief 43-44; Reply Brief 7, 9-10). We  
13 disagree with the Appellant.

14 As an initial matter, Appellant has not set forth any definition of audio  
15 or video presentation in the claims that would exclude audio signals of  
16 videotext. *See CollegeNet, Inc.*, 418 F.3d at 1231.

17 Moreover, Filepp additionally discloses applications on the interactive  
18 computer system network that include text/graphic sessions, presentation  
19 data, videotext, sounds, graphics data, pictorial codes and presentation media  
20 (col. 2, ll. 23-38; col. 18, ll. 40-55; col. 59, ll. 53-62; col. 65, ll. 50-64; col.  
21 83, ll. 3-11; col. 90, l. 60 through col. 91, l. 13). One or more of these  
22 features constitute an audio or video presentation under a broadest  
23 reasonable interpretation. *See In re Am. Acad. Of Sci. Tech Ctr.*, 367 F.3d at  
24 1364.

25 We will sustain this rejection of claims 35, 48 and 68.

1

2           *Auctioning Services, Housing Information/New Rejection*

3           The third issue in regard to this rejection is whether the Appellant has  
4 shown that the Examiner erred in asserting that Filepp discloses auctioning  
5 services as recited in claim 53, and information about the sale or financing  
6 of housing as recited in claims 95 and 103.

7           The Appellant asserts that Filepp does not disclose wherein the  
8 goods and services include auctioning services as recited in claim 53, and  
9 providing information about the sale or financing of housing as recited in  
10 claims 95 and 103 (Appeal Brief 44-45). Even assuming that we agree with  
11 the Appellant, we nonetheless are of the opinion that claims 53, 95 and 103  
12 merely constitute descriptive materials that are unrelated to the underlying  
13 apparatus in any functional way. *See In re Ngai*, 367 F.3d at 1339.

14 Specifically, the underlying apparatus including central communications  
15 facilities and remote communications facilities will not function differently  
16 whether the information presented is for auctioning services or housing.

17           Therefore, we will sustain the rejection as it is directed to claims 53,  
18 95 and 103. However, because our rationale differs from the rationale of  
19 the Examiner, we denominate this a new rejection pursuant to 37 C.F.R.  
20 § 41.50(b).

21

22           *Computerized Voice*

23           The fourth issue in regard to this rejection is whether the Appellant  
24 has shown that the Examiner erred in asserting that the computerized voice  
25 as recited in claim 69 is similar to the subject matter of claim 36.

1       The Examiner asserts that the computerized voice of claim 69 is  
2 similar in scope to the subject matter of claim 36, and thus is rejected on the  
3 same basis (Office Action 23). We disagree with the Examiner and agree  
4 with the Appellant's arguments on page 44 of the Appeal Brief. Claim 36  
5 recites "means for recording a presentation stopping point for future  
6 reference," and is rejected as being obvious over a combination of AT&T,  
7 Dworkin and Official Notice of a presentation stopping point. The  
8 presentation stopping point of claim 36 is not similar in subject matter to the  
9 computerized voice of claim 69.

10      We will not sustain this rejection of claim 69.

11

12      *Other Claims*

13      The fifth issue in regard to this rejection is whether the Appellant has  
14 shown that the Examiner erred in rejecting claims 34, 38, 52, 94 and 107.

15      In addition to a lack of motivation for combining AT&T and Filepp,  
16 which has been addressed above, the Appellant asserts that claims 34, 38,  
17 52, 94 and 107 are also allowable because they either (1) depend from  
18 an allowable claim, or (2) are substantially similar to an allowable claim  
19 (Appeal Brief 42-44). We disagree with the Appellant. The rejection of the  
20 claims from which these claims either depend or are substantially similar to  
21 has been sustained. Accordingly, the rejection of these claims is also  
22 sustained.

23

24      Rejection of claims 70-76 under 35 U.S.C. § 103(a) as being  
25      unpatentable over AT&T in view of Dworkin and McCalley

1           *Select and Contact*

2           The first issue in regard to this rejection is whether the Appellant has  
3           shown that the Examiner erred in asserting that AT&T discloses “said  
4           central communications facility adapted to enable said customer to select  
5           and contact at least one other central communications facility providing  
6           information relating to goods and services” as recited in claim 70.

7           The Appellant asserts that AT&T does not disclose enabling a  
8           customer to select and contact at least one other computerized central  
9           communications facility as recited in claim 70 (Appeal Brief 45-46; Reply  
10          Brief 10). We disagree with the Appellant.

11          The claim only recites *enabling* a customer to select and contact at  
12          least one other computerized central communications facility. The claim  
13          does not *require* the customer to select and contact at least one other  
14          computerized central communications facility, through AT&T’s software  
15          architecture or otherwise, in order to meet the claim recitation. *See*  
16          *CollegeNet, Inc.*, 418 F.3d at 1231.

17          AT&T discloses a directory of directories, and a user performs a word  
18          search on AT&T to find out where information is located, for example,  
19          which directory. Once these results are returned, the user *may* use the  
20          information to contact that directory so as to contact businesses listed in that  
21          directory. Accordingly, once the word search results are returned, the user is  
22          *enabled* to select and contact this directory using any suitable means, and the  
23          claim recitation is satisfied under a broadest reasonable interpretation. *See*  
24          *In re Am. Acad. Of Sci. Tech Ctr.*, 367 F.3d at 1364. The fact that AT&T  
25          may or may not *actually* disclose the user selecting and contacting the

1 directory, whether through the software architecture of AT&T or other  
2 means, is irrelevant, as those recitations are not set forth in the claims. *See*  
3 *CollegeNet, Inc. v. ApplyYourself, Inc.*, 418 F.3d at 1231.

4 We will sustain this rejection of claim 70 and claims 71-76 which  
5 depend therefrom.

6

7 *Motivation*

8 The second issue in regard to this rejection is whether the Appellant  
9 has shown that the Examiner erred in combining the single central facility  
10 of Dworkin with the multiple central facilities of AT&T because there is no  
11 motivation to combine the references (Appeal Brief 45-46). We disagree  
12 with the Appellant for the same reasons as set forth above.

13

14 *Non-Analogous Art*

15 The third issue in regard to this rejection is whether the Appellant has  
16 shown that the Examiner erred in combining the single central facility of  
17 Dworkin with the multiple central facilities of AT&T because Dworkin and  
18 AT&T are non-analogous art (Appeal Brief 45-46). We disagree with the  
19 Appellant for the same reasons as set forth above.

20

21 Rejection of claims 93, 96-98, 101, and 104-106 under 35 U.S.C.  
22 § 103(a) as being unpatentable over AT&T in view of Dworkin and  
23 Examiner's Official Notice

24 *Employee Recruiting Information/New Rejection*

1       The first issue in regard to this rejection is whether the Appellant  
2 has shown that the Examiner erred in taking Official Notice of providing  
3 employee recruiting information as recited in claims 93 and 101.

4       The Appellant asserts that the Official Notice of the providing  
5 employee recruiting information recited in claims 93 and 101 was improper  
6 because the use of Official Notice is generally improper (Appeal Brief 46).  
7 We disagree with the Appellant.

8       At no point in the prosecution of this application has Appellant  
9 properly challenged the Official Notice by providing any factual or technical  
10 arguments as to why the Official Notice is improper, i.e., why a providing  
11 employee recruiting information is not capable of instant and unquestionable  
12 demonstration as being well-known<sup>2</sup>. Mere general assertions by the  
13 Appellant that “the use of Official Notice itself is highly questionable” and  
14 that because “this application is under final action such a use then of Official  
15 Notice should be rare” do not constitute factual or technical arguments that  
16 could properly challenge Official Notice (Appeal Brief 46). Factual or  
17 technical arguments would address the substance of the Official Notice by  
18 specifically referencing employee recruiting information. Absent such  
19 factual or technical arguments, Appellant cannot prevail. *In re Chevenard*,  
20 139 F.2d 711, 713.

21       Moreover, even assuming that we agree with the Appellant, we  
22 nonetheless are of the opinion that claims 93 and 101 merely constitute  
23 descriptive materials that are unrelated to the underlying apparatus in  
24 any functional way. *See In re Ngai*, 367 F.3d at 1339. Specifically, the

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<sup>2</sup> No proper challenge of Official Notice is set forth on either page 46 of the Appeal Brief or pages 20-21 of Supplemental Amendment filed July 6, 2004.

1 underlying apparatus including central communications facilities and remote  
2 communications facilities will not function differently whether or not the  
3 information provided concerns employee recruiting information.

4 Therefore, we will sustain the rejection as it is directed to claims 93  
5 and 101. However, because our rationale differs from the rationale of the  
6 Examiner, we denominate this a new rejection pursuant to 37 C.F.R.  
7 § 41.50(b).

8

9           *Coupons*

10          The second issue in regard to this rejection is whether the Appellant  
11 has shown that the Examiner erred in taking Official Notice of providing  
12 coupons relating to goods and services as recited in claims 96, 97, 104 and  
13 105.

14          The Appellant asserts that the Official Notice of the providing  
15 coupons related to goods and services recited in claims 96, 97, 104 and 105  
16 was improper because the use of Official Notice is generally improper  
17 (Appeal Brief 46). We disagree with the Appellant.

18          At no point in the prosecution of this application has Appellant  
19 properly challenged the Official Notice by providing any factual or technical  
20 arguments as to why the Official Notice is improper, i.e., why a providing  
21 coupons related to goods and services is not capable of instant and  
22 unquestionable demonstration as being well-known<sup>3</sup>. Mere general  
23 assertions by the Appellant that “the use of Official Notice itself is highly  
24 questionable” and that because “this application is under final action such a

---

<sup>3</sup> No proper challenge of Official Notice is set forth on either page 46 of the Appeal Brief or pages 20-21 of Supplemental Amendment filed July 6, 2004.

1 use then of Official Notice should be rare" do not constitute factual or  
2 technical arguments that could properly challenge Official Notice (Appeal  
3 Brief 46). Factual or technical arguments would address the substance of the  
4 Official Notice by specifically referencing coupons related to goods and  
5 services. Absent such factual or technical arguments, Appellant cannot  
6 prevail. *In re Chevenard*, 139 F.2d 711, 713.

7 We will sustain this rejection of claims 96, 97, 104 and 105.

8

9 *Charging Fees for Information*

10 The third issue in regard to this rejection is whether the Appellant  
11 has shown that the Examiner erred in taking Official Notice of charging  
12 customers a fee for information as recited in claims 98 and 106.

13 The Appellant asserts that the Official Notice of charging customers a  
14 fee for information recited in claims 98 and 106 was improper because the  
15 use of Official Notice is generally improper (Appeal Brief 46). We disagree  
16 with the Appellant.

17 At no point in the prosecution of this application has Appellant  
18 properly challenged the Official Notice by providing any factual or technical  
19 arguments as to why the Official Notice is improper, i.e., why charging  
20 customers a fee for information is not capable of instant and unquestionable  
21 demonstration as being well-known<sup>4</sup>. Mere general assertions by the  
22 Appellant that "the use of Official Notice itself is highly questionable" and  
23 that because "this application is under final action such a use then of Official  
24 Notice should be rare" do not constitute factual or technical arguments that

---

<sup>4</sup> No proper challenge of Official Notice is set forth on either page 46 of the Appeal Brief or pages 20-21 of Supplemental Amendment filed July 6, 2004.

1 could properly challenge Official Notice (Appeal Brief 46). Factual or  
2 technical arguments would address the substance of the Official Notice by  
3 specifically referencing charging customers a fee for information. Absent  
4 such factual or technical arguments, Appellant cannot prevail. *In re*  
5 *Chevenard*, 139 F.2d 711, 713.

6 We will sustain this rejection of claims 98 and 106.

7

8 Rejection of claims 108, 110-114 and 139 under 35 U.S.C. § 103(a)  
9 as being unpatentable over Saigh in view of Lockwood

10 The sole issue in regard to this rejection is whether the Appellant  
11 has shown that the Examiner erred in asserting that Saigh is prior art to the  
12 subject matter of claims 108, 110-114 and 139 because parent Application  
13 No. 08/268,309 filed June 29, 1994 does not provide written description  
14 support for multiple central communications facilities (Appeal Brief 47-48;  
15 Reply Brief 11-12). We agree with the Appellant for the same reasons as set  
16 forth above.

17 We will not sustain this rejection of claims 108, 110-114 and 139.

18

19 Rejection of claim 109 under 35 U.S.C. § 103(a) as being  
20 unpatentable over Saigh in view of Lockwood and Ferguson

21 Findings of Fact

22 The '309 application discloses auctioning services (p. 6, ll. 31-34).

23

24 Analysis

25 *Saigh*

1       The first issue in regard to this rejection is whether the Appellant has  
2 shown that the Examiner erred in asserting that Saigh is prior art to the  
3 subject matter of claim 109 because parent Application No. 08/268,309 filed  
4 June 29, 1994 does not provide written description support for multiple  
5 central communications facilities (Appeal Brief 48; Reply Brief 12). We  
6 agree with the Appellant for the same reasons as set forth above.

7       We will not sustain this rejection of claim 109.

8

9                  *Ferguson*

10       Even though we have sustained the rejection of claim 109, we will  
11 continue our analysis of the rejection, particularly with respect to Ferguson,  
12 given that subsequent claims depend on the outcome of such analysis.  
13 Accordingly, we determine whether the Appellant has shown that the  
14 Examiner erred in asserting that Ferguson is prior art to the subject matter of  
15 claim 109 because parent Application No. 08/268,309 filed June 29, 1994  
16 does not provide written description support for auctioning services.

17       Claim 109 has been rejected under 35 U.S.C. § 103(a) using  
18 Ferguson. This application was filed on March 29, 1996, and is a  
19 continuation-in-part application of the '309 application which was filed  
20 on June 29, 1994. As an initial matter, we must determine whether the  
21 Appellant has shown that the '309 application adequately supports the  
22 subject matter of the aforementioned claims. *See Wagoner*, 463 F.2d at  
23 1380.

1       The Appellant asserts that the '309 application, to which this  
2 application claim priority, does provide support for auctioning services  
3 (Appeal Brief 48; Reply Brief 12). We agree with the Appellant.

4       The '309 application does provide written description support for  
5 auctioning services, for example, at p. 6, ll. 31-34 of the '309 application.  
6 Accordingly, the effective filing date for claim 109 is the June 29, 1994  
7 filing date of the '309 application.

8       Ferguson has a filing date of October 6, 1997, and is a continuation  
9 of an application filed November 8, 1994. Accordingly, the June 29, 1994  
10 effective filing date of the aforementioned claim antedates the November 8,  
11 1994 effective date of Ferguson.

12      We will not sustain this rejection of claim 109.

13

14      Rejection of claim 139 under 35 U.S.C. § 103(a) as being  
15      unpatentable over Saigh in view of Lockwood

16       The sole issue in regard to this rejection is whether the Appellant has  
17 shown that the Examiner erred in asserting that Saigh is prior art to the  
18 subject matter of claim 139 because parent Application No. 08/268,309 filed  
19 June 29, 1994 does not provide written description support for multiple  
20 central communications facilities (Appeal Brief 49; Reply Brief 13). We  
21 agree with the Appellant for the same reasons as set forth above.

22      We will not sustain this rejection of claim 139.

23

24      Rejection of claim 124 under 35 U.S.C. § 103(a) as being  
25      unpatentable over Saigh

1       The sole issue in regard to this rejection is whether the Appellant  
2 has shown that the Examiner erred in asserting that Saigh is prior art to the  
3 subject matter of claim 124 because parent Application No. 08/268,309 filed  
4 June 29, 1994 does not provide written description support for multiple  
5 central communications facilities (Appeal Brief 49; Reply Brief 13). We  
6 agree with the Appellant for the same reasons as set forth above.

7       We will not sustain this rejection of claim 124.

8

9       Rejection of claim 125 under 35 U.S.C. § 103(a) as being  
10      unpatentable over Gifford in view of Ferguson

11       The sole issue in regard to this rejection is whether the Appellant has  
12 shown that the Examiner erred in asserting that Ferguson is prior art to the  
13 subject matter of claim 125 because parent Application No. 08/268,309 filed  
14 June 29, 1994 does not provide written description support for auctioning  
15 services (Appeal Brief 49; Reply Brief 13). We agree with the Appellant for  
16 the same reasons as set forth above.

17       We will not sustain this rejection of claim 125.

18

19       Rejection of claim 126 under 35 U.S.C. § 103(a) as being  
20      unpatentable over Gifford in view of Lockwood

21       The sole issue in regard to this rejection is whether the Appellant has  
22 shown that the Examiner erred in rejecting claim 126.

23       The Appellant asserts that claim 126 is allowable because it depends  
24 from allowable independent claim 123 (Appeal Brief 49-50). We disagree

1 with the Appellant. The rejection of claim 123 has been sustained.

2 Accordingly, the rejection of claim 126 is also sustained.

3

4       Rejection of claims 127-129 under 35 U.S.C. § 103(a) as being  
5       unpatentable over Gifford in view of Saigh

6       The sole issue in regard to this rejection is whether the Appellant  
7 has shown that the Examiner erred in asserting that Saigh is prior art to the  
8 subject matter of claims 127-129 because parent Application No. 08/268,309  
9 filed June 29, 1994 does not provide written description support for multiple  
10 central communications facilities (Appeal Brief 50-51; Reply Brief 14). We  
11 agree with the Appellant for the same reasons as set forth above.

12      We will not sustain this rejection of claims 127-129.

13

14       Rejection of claims 130-132 and 135-137 under 35 U.S.C. § 103(a)  
15       as being unpatentable over Saigh in view of InTouch

16       The sole issue in regard to this rejection is whether the Appellant has  
17 shown that the Examiner erred in asserting that Saigh is prior art to the  
18 subject matter of claims 130-132 and 135-137 because parent Application  
19 No. 08/268,309 filed June 29, 1994 does not provide written description  
20 support for multiple central communications facilities (Appeal Brief 51-53;  
21 Reply Brief 15-16). We agree with the Appellant for the same reasons as set  
22 forth above.

23      We will not sustain this rejection of claims 130-132 and 135-137.

24

1       Rejection of claim 133 under 35 U.S.C. § 103(a) as being  
2       unpatentable over Saigh in view of InTouch and Ferguson

3           *Saigh*

4       The first issue in regard to this rejection is whether the Appellant  
5       has shown that the Examiner erred in asserting that Saigh is prior art to the  
6       subject matter of claim 133 because parent Application No. 08/268,309 filed  
7       June 29, 1994 does not provide written description support for multiple  
8       central communications facilities (Appeal Brief 53-54; Reply Brief 16). We  
9       agree with the Appellant for the same reasons as set forth above.

10      We will not sustain this rejection of claim 133.

11  
12           *Ferguson*

13       The second issue in regard to this rejection is whether the Appellant  
14       has shown that the Examiner erred in asserting that Ferguson is prior art to  
15       the subject matter of claim 133 because parent Application No. 08/268,309  
16       filed June 29, 1994 does not provide written description support for  
17       auctioning services (Appeal Brief 53-54; Reply Brief 16). We agree with  
18       the Appellant for the same reasons as set forth above.

19      We will not sustain this rejection of claim 133.

20  
21       Rejection of claim 134 under 35 U.S.C. § 103(a) as being  
22       unpatentable over Saigh in view of InTouch and Lockwood

23       The sole issue in regard to this rejection is whether the Appellant  
24       has shown that the Examiner erred in asserting that Saigh is prior art to the  
25       subject matter of claim 134 because parent Application No. 08/268,309 filed

1 June 29, 1994 does not provide written description support for multiple  
2 central communications facilities (Appeal Brief 54; Reply Brief 16-17). We  
3 agree with the Appellant for the same reasons as set forth above.

4 We will not sustain this rejection of claim 134.

5

6 Rejection of claim 138 under 35 U.S.C. § 103(a) as being  
7 unpatentable over Saigh in view of InTouch and Ferguson

8 *Saigh*

9 The first issue in regard to this rejection is whether the Appellant  
10 has shown that the Examiner erred in asserting that Saigh is prior art to the  
11 subject matter of claim 138 because parent Application No. 08/268,309 filed  
12 June 29, 1994 does not provide written description support for multiple  
13 central communications facilities (Appeal Brief 54; Reply Brief 17). We  
14 agree with the Appellant for the same reasons as set forth above.

15 We will not sustain this rejection of claim 138.

16

17 *Ferguson*

18 The second issue in regard to this rejection is whether the Appellant  
19 has shown that the Examiner erred in asserting that Ferguson is prior art to  
20 the subject matter of claim 138 because parent Application No. 08/268,309  
21 filed June 29, 1994 does not provide written description support for  
22 auctioning services (Appeal Brief 54; Reply Brief 17). We agree with the  
23 Appellant for the same reasons as set forth above.

24 We will not sustain this rejection of claim 138.

25

1       Rejection of claim 30 under the judicially created doctrine of  
2       obviousness-type double patenting as being unpatentable over Wren in  
3       view of AT&T and Dworkin

4           The sole issue in regard to this rejection is whether the Appellant has  
5       shown that the Examiner erred in asserting that claim 30 was unpatentable  
6       for obviousness-type double patenting over claims 1-5 of Wren in view of  
7       AT&T and Dworkin.

8           The Appellant asserts that the obviousness-type double patenting  
9       rejection of claim 30 is improper because claim 30 includes aspects that are  
10      not present in claims 1-5 of Wren (Appeal Brief 54-55; Reply Brief 17). We  
11      disagree with the Appellant.

12          Appellant appears to be confusing *statutory* double patenting and  
13      *obviousness-type* double patenting. Under *statutory* double patenting,  
14      Appellant is correct that the only claims that may be rejected are claims that  
15      are identical. Claim 30 of this application and claims 1-5 of Wren are not  
16      identical. Under *obviousness-type* double patenting, however, the claims are  
17      not identical because the application claim includes an aspect that is not  
18      present in the patent claim. In that case, another reference including the  
19      missing aspect is identified and combined with the patent claim to render the  
20      application claim obvious. Such is the case here.

21          The Examiner is conceding that claim 1 of Wren does not include  
22      certain aspects of claim 30. However, the Examiner is then asserting that  
23      either AT&T or Dworkin discloses those aspects, and then is combining  
24      claim 1 of Wren with those aspects of AT&T and Dworkin to render claim  
25      30 obvious (Office Action 41-43). As the Examiner has established a proper

1       *prima facie* case of obviousness, and Appellant has not set forth any  
2       arguments as to why the combination is improper, we will sustain this  
3       rejection. *See In re Keller*, 642 F.2d at 425.

4           We will sustain this rejection of claim 30.

5

6       Rejection of claims 108-114 and 130-143 under the judicially  
7       created doctrine of obviousness-type double patenting as being  
8       unpatentable over Wren in view of Saigh, Ferguson, InTouch, and  
9       Lockwood

10          The sole issue in regard to this rejection is whether the Appellant has  
11       shown that the Examiner erred in asserting that claims 108-114 and 130-143  
12       were unpatentable for obviousness-type double patenting over claims 1-5 of  
13       Wren in view of Saigh, Ferguson, Intouch and Lockwood.

14          The Appellant asserts that the obviousness-type double patenting  
15       rejection of claims 108-114 and 130-143 is improper because claims 108,  
16       130, 138 and 140 include aspects that are not present in claims 1-5 of Wren  
17       (Appeal Brief 55-56; Reply Brief 18). Again, Appellant appears to be  
18       confusing *statutory* double patenting and *obviousness-type* double patenting.  
19       Claims 108-114 and 130-143 have been rejected under *obviousness-type*  
20       double patenting.

21          The Examiner concedes that claims 1-5 of Wren do not include  
22       certain aspects of claims 108-114 and 130-143 (Office Action 43-44). The  
23       Examiner then asserts that at least one of Saigh, Ferguson, InTouch and  
24       Lockwood discloses those aspects. However, the Examiner only sets forth  
25       a rationale for combining Saigh and claims 1-5 of Wren (Office Action 43-

1 44). As Saigh is not prior art to claims 108-114 and 130-143 for the reasons  
2 set forth above, this rejection is no longer effective.

3 The Examiner attempts to remedy this by citing Dworkin as allegedly  
4 remedying the deficiencies of claims 1-5 of Wren (Examiner's Answer 21-

<sup>5</sup> 22). However, Dworkin was not originally cited for this rejection and thus

<sup>6</sup> we will not consider it. See *In re Hoch*, 428 F.2d at 1342 n. 3. Compare *In*

<sup>7</sup> *re Cowles*, 156 F.2d at 551; *In re Christensen et al.*, 166 F.2d at 825.

8 Moreover, the Examiner has not set forth a rationale as to how claims 1-5 of

<sup>9</sup> Wren and Dworkin render obvious the aspects of claims 108, 130, 138 and

<sup>10</sup> – 140 cited by Appellant at pages 55, 56 of the Appeal Brief. See *In re Koller*.

11 - 642 E 21 - 425 P - 21-22-3-4 - English 14 - 14 - 14

11 - 572456 at 123. Pages 21-22 of the Examiner's Answer only assert that

<sup>12</sup> Dworkin discloses periodically updating a database, which is not reflected.

13 in any of the aspects of claims 108, 130, 138 and 140 cited by Appellant.

## CONCLUSIONS OF LAW

18 The Appellant has failed to show that the Examiner erred in rejecting  
19 claims 30, 31, 33-36, 38, 40, 42-45, 47-53, 57, 59-68, 70-107, 123 and 126.

20 The Appellant has shown that the Examiner erred in rejecting claims  
21 32, 39, 41, 54, 58, 69, 108-116, 121, 122, 124, 125 and 127-143.

22 Claims 117-120 are directed to non-elected species, were withdrawn  
23 from consideration in the final Office Action mailed July 18, 2005, and thus  
24 have not been considered in this opinion.

1       The Appellant did show that the Examiner erred in asserting that  
2 Saigh is prior art to the subject matter of claims 108-116, 121, 122, 124 and  
3 127-143 because parent Application No. 08/268,309 filed June 29, 1994  
4 does not provide written description support for multiple central  
5 communications facilities.

6       The Appellant did not show that the Examiner erred in asserting  
7 that Gifford discloses using downloaded software to display or reproduce  
8 “information contained in a transmitted hypermedia document” as recited  
9 in claim 123.

10       The Appellant did not show that the Examiner erred in asserting that  
11 AT&T discloses an apparatus to market and/or sell goods and/or services as  
12 recited in claims 30 and 44.

13       The Appellant did not show that the Examiner erred in asserting that  
14 AT&T discloses at least one of said computerized central communications  
15 facilities is adapted to provide to said customer at said computerized remote  
16 facility a list of computerized central communications facilities permitting  
17 said customer to select and contact at least one other computerized central  
18 communications facility as recited in claims 30 and 44.

19       The Appellant did not show that the Examiner erred in combining the  
20 single central facility of Dworkin with the multiple central facilities of  
21 AT&T because (1) there is no motivation to combine the references and (2)  
22 Dworkin and AT&T are non-analogous art.

23       The Appellant did show that the Examiner erred in asserting that  
24 Dworkin discloses “wherein at least one of said computerized central  
25 communications facilities is further programmed to contact the customer and

1 apprise said customer of goods or services offered or any special offerings”  
2 as recited in claim 32.

3       The Appellant did not show that the Examiner erred in asserting that  
4 AT&T discloses “wherein said computerized central communications  
5 facility and each of said other computerized central communications  
6 facilities are associated with competing providers of goods and services” as  
7 recited in claim 33.

8       The Appellant did not show that the Examiner erred in taking Official  
9 Notice of providing a stopping point in a user presentation as recited in  
10 claims 36 and 51.

11       The Appellant did show that the Examiner erred in asserting that  
12 AT&T discloses a processor programmed to download software from a  
13 computerized central communications facility to a remote communications  
14 facility as recited in claims 39, 41 and 58.

15       The Appellant did not show that the Examiner erred in asserting that  
16 Dworkin discloses “a second central communications facility having a  
17 database of information relating to a second set of information relating to  
18 goods or services to provide upon request” as recited in claim 44.

19       The Appellant did show that the Examiner erred in asserting that  
20 Dworkin discloses “a software application for assisting the central  
21 communications facility to download a contract to the computerized remote  
22 location” as recited in claim 54.

23       The Appellant did not show that the Examiner erred in asserting that  
24 Dworkin discloses “wherein said first central communications facility

1 further enables said customer to browse said first set of information relating  
2 to goods and services" as recited in claim 79.

3 The Appellant did not show that the Examiner erred in asserting that  
4 Dworkin discloses "enabling the remote facility to search said first database  
5 or said second database" as recited in claim 81.

6 The Appellant did not show that the Examiner erred in rejecting  
7 claims 31, 40, 42, 43, 45, 47, 49, 51, 57-64, 67, 80, 82-85, 87-90, 92 and  
8 100.

9 The Appellant did not show that the Examiner erred in rejecting  
10 claims 50, 72, 77, 78 and 86.

11 The Appellant did not show that the Examiner erred in combining the  
12 single central facility of Filepp with the multiple central facilities of AT&T  
13 because (1) there is no motivation to combine the references and (2) Filepp  
14 and AT&T are non-analogous art.

15 The Appellant did not show that the Examiner erred in asserting that  
16 Filepp discloses that a computerized communications facility is adapted to  
17 provide information relating to goods and services in the form of an audio or  
18 video presentation as recited in claims 35, 48 and 68.

19 The Appellant did show that the Examiner erred in asserting that  
20 Filepp discloses auctioning services as recited in claim 53 and information  
21 about the sale or financing of housing as recited in claims 95 and 103?

22 The Appellant did show that the Examiner erred in asserting that the  
23 computerized voice as recited in claim 69 is similar to the subject matter of  
24 claim 36.

1       The Appellant did not show that the Examiner erred in rejecting  
2 claims 34, 38, 52, 94 and 107.

3       The Appellant did not show that the Examiner erred in asserting that  
4 AT&T discloses “said central communications facility adapted to enable  
5 said customer to select and contact at least one other central communications  
6 facility providing information relating to goods and services” as recited in  
7 claim 70.

8       The Appellant did show the Examiner erred in taking Official Notice  
9 of providing employee recruiting information as recited in claims 93 and  
10 101.

11       The Appellant did not show that the Examiner erred in taking Official  
12 Notice of providing coupons relating to goods and services as recited in  
13 claims 96, 97, 104 and 105.

14       The Appellant did not show that the Examiner erred in taking Official  
15 Notice of charging customers a fee for information as recited in claims 98  
16 and 106.

17       The Appellant did show that the Examiner erred in asserting that  
18 Ferguson is prior art to the subject matter of claims 109, 125, 133, 134 and  
19 138 because parent Application No. 08/268,309 filed June 29, 1994 does not  
20 provide written description support for auctioning services.

21       The Appellant did not show that the Examiner erred in rejecting claim  
22 126.

23       The Appellant did not show that the Examiner erred in asserting that  
24 claim 30 was unpatentable for obviousness-type double patenting over  
25 claims 1-5 of Wren in view of AT&T and Dworkin.

1 The Appellant did show the Examiner erred in asserting that claims  
2 108-114 and 130-143 were unpatentable for obviousness-type double  
3 patenting over claims 1-5 of Wren in view of Saigh, Ferguson, Intouch and  
4 Lockwood.

## DECISION

7 The decision of the Examiner to reject claims 30, 31, 33-36, 38, 40,  
8 42-45, 47-53, 57, 59-68, 70-107, 123 and 126 is affirmed. The decision of  
9 the Examiner to reject claims 32, 39, 41, 54, 58, 69, 108-116, 121, 122, 124,  
10 125 and 127-143 is reversed. Claims 117-120 are still withdrawn from  
11 consideration.

12 We have entered new two new ground of rejection under 37 C.F.R.  
13 § 41.50(b): (1) claims 53, 95 and 103 are rejected under 35 U.S.C. § 103(a)  
14 as being unpatentable over AT&T, Dworkin and Filepp; and (2) claims 93  
15 and 101 are rejected under 35 U.S.C. § 103(a) as being unpatentable over  
16 AT&T and Dworkin.

37 C.F.R. § 41.50(b) provides that, “[a] new ground of rejection pursuant to this paragraph shall not be considered final for judicial review.”

19       Regarding the new ground of rejection, Appellant must, WITHIN  
20   TWO MONTHS FROM THE DATE OF THE DECISION, exercise one of  
21   the following options with respect to the new ground of rejection, in order to  
22   avoid termination of the appeal as to the rejected claims:

(1) *Reopen prosecution.* Submit an appropriate amendment of the claims so rejected or new evidence relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the proceeding will be remanded to the examiner. . . [; or]

1           (2) *Request rehearing.* Request that the proceeding be reheard under  
2           § 41.52 by the Board upon the same record. . . .

3           No time period for taking any subsequent action in connection  
4           with this appeal may be extended under 37 C.F.R. § 1.136(a).

5

6           AFFIRMED-IN-PART; 37 C.F.R. § 41.50(b)

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11 JRG

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